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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,181	12/12/2000	John Edward Andrew Shaw	20-954	9642

7590

07/22/2003

William H Bollman
Farkas & Manelli
Suite 700
2000 M Street N W
Washington, DC 20036-3307

EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 07/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,181

Applicant(s)

SHAW, JOHN EDWARD ANDREW

Examiner

Lyle A Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 53-76 and 78-84 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Burns et al.

See the appropriate paragraph of paper 7.

With respect to the new limitations directed to "reversibly, thermally deformable" column 6 lines 54-65 and columns 22-23 lines 47-30 respectively, teach a heating means and a melt able material that is able to partially resolidify (co. 23 lines 16-19) when cooled. This has been read on the claimed "reversibly, thermally deformable". Column 23 lines 26-29 teach the melt able material can be wax, polymer or plastic. The claim limitation of "resiliently deformable" meets the limitations of the Burns et al. because prior to heating the material is resilient to the passage of fluid.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al.

Burns et al. teach in column 23 lines 26-29 the melt able material can be wax, polymer or plastic. Burns et al. is silent to the claimed polypropylene polystyrene polymer.

The court decided In re Leshin (125 USPQ 215) the selection of a plastic/polymer being on the basis of its suitability of intended use would have been entirely obvious.

Polypropylene polystyrene is known to be inert, inexpensive and easy to fabricate. Such materials are well suited for disposable diagnostic devices because the material is inert to most biological fluids, is inexpensive and can be readily manufacture into a variety of configurations.

It would have been within the skill of the art to modify Burns et al. to select a polymer, such as polypropylene polystyrene, to gain the above advantages of being inert, inexpensive and easy to fabricate. Furthermore, Leshin above also states such a modification would have been obvious as selection of a material based upon its suitability of intended use.

Response to Arguments

Applicant's arguments filed 5/19/03 have been fully considered but they are not persuasive.

Applicants state Burns et al. fail to teach the claimed "reversibly, thermally deformable" material. The Office maintains Burns et al. teach in column 6 lines 54-65 and columns 22-23 lines 47-30 respectively, a melt able material that is able to partially resolidify (co. 23 lines 16-19) when cooled. This has been read on the claimed "reversibly, thermally deformable".

Applicant's remarks and amendments were convincing in overcoming Gubinski.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander
Primary Examiner
Art Unit 1743

July 18, 2003